No. 753



# In the Supreme Court of the United States

OCTOBER TERM, 1945

R. G. LeTOURNEAU, INC.,
*Petitioner,*
vs.
GAR WOOD INDUSTRIES, INC.,
*Respondent.*

## Petition for Review on Writ of Certiorari and Brief in Support Thereof

WEBSTER AND WEBSTER,
PERCY S. WEBSTER,
NAYLOR AND LASSAGNE,
THEODORE H. LASSAGNE,
Russ Building,
San Francisco, California,
*Attorneys for Petitioner.*

PARKER PRINTING COMPANY, 545 SANSOME STREET, SAN FRANCISCO

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## Petition for Review on Writ of Certiorari

**To the United States Circuit Court of Appeals for the Ninth Circuit**

*To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:*

This petition of R. G. LeTourneau, Inc., respectfully prays that in accordance with the provisions of the United States Code, Title 28, Section 347(a), the United States Circuit Court of Appeals for the Ninth Circuit be required by writ of certiorari issued by the Supreme Court of the United States to certify to it for determination the single question hereinafter set forth, presented by the above identified case in which the decision of the said Circuit Court of Appeals was rendered on October 19, 1945.

## SUMMARY STATEMENT OF MATTER INVOLVED

This case presents a single fundamental question of patent law, which petitioner asks be reviewed and determined by this Court:

> Where invention was required to conceive the idea of combining old elements to produce an improved result, thereby providing a machine of greater utility; but, given the inventive conception, it was more a matter of mechanical skill than of invention to devise an embodiment of it, has a patentable invention been made?

A negative answer to this question was the *sole* basis of the decision of the Circuit Court of Appeals for the Ninth Circuit.

Both the District Court and the Circuit Court of Appeals treated as immaterial evidence that the patentee, R. G. LeTourneau, exercised invention in conceiving the idea of combining old elements to produce an improved result, and it was not questioned that the resulting machine was of greater utility than any machine theretofore provided for similar purposes.

The District Court, however, held the LeTourneau patent in suit void for want of invention on the *sole* ground that it was a matter of mere mechanical skill to devise an embodiment of the patentee's inventive concept, after one had been told what that concept was.

The Circuit Court of Appeals affirmed the decision of the District Court on the *sole* ground that because the thing patented was an improvement on an existing type of machine (as distinguished from a wholly new type of machine producing a result "different in nature" from

results achieved by previous machines), invention must be involved in devising an embodiment of the patentee's concept in order to sustain the patent claims sued upon; it being immaterial whether or not invention was required to conceive the ideas embodied in the machine.

The same principle was applied by the Circuit Court of Appeals in holding the claims sued upon in both of the patents in suit void for want of invention. The comparative importance of the inventions of the respective patentees is such, however, that review by this Court is sought only as to the LeTourneau patent No. 1,963,665 dated June 19, 1934.

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## REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT

The sound judicial discretion of this Court is invoked by this petition for the following reasons:

### 1. The Question Presented Is of Great Public Importance.

Judicial interpretation of the provisions of the patent laws requiring "invention" as a condition precedent to the sustaining of letters patent is submitted as constituting a matter of the greatest public importance at the present time, as evidenced by the manifold official statements and legal commentaries thereon referred to in the brief in support of this petition.

By this petition, review is sought of a ruling which would invalidate all patents within a field in which the public interest is most important. Struck down would be all improvement patents—even those in which the "flash of genius" was required for the conception of the funda-

mental idea making possible the creation of the thing patented—, if it can be shown that a person skilled in the art could put the parts together without further invention *after having been given the fundamental inventive concept.*

This withdrawal of incentive for the improvement of existing machines is so plainly abortive of the Constitutional purpose "to promote the progress of science and the useful arts", and so damaging to the public interest, as to urgently require the intervention of this Court.

**2. The Circuit Court of Appeals Has Decided the Question Presented in a Way in Conflict With Applicable Decisions of This Court and With the Weight of Authority.**

This Court expressly decided in *National Cash Register Co. vs. Boston Cash Indicator and Recorder Co.* 156 U.S. 502, that invention may be found in the conception of the idea of combining old instrumentalities to secure an improved and superior result providing a machine of greater utility, even though, given the conception, it would be more a matter of mechanical skill than invention to devise the mechanism patented.

No decision of this Court has overruled or modified that decision.

The Circuit Court of Appeals for the Ninth Circuit has decided the present case in a way in conflict with the above cited decision in holding that invention may be found in such a conception only if a result "different in nature", as distinguished from an improved or superior result, is achieved.

WHEREFORE your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of

this Honorable Court directed to the Circuit Court of Appeals for the Ninth Circuit commanding that court to certify and to send to this Court for its review and determination on a day certain to be therein named a transcript of the record and proceedings herein, and that the judgment of the United States District Court for the Northern District of California, Southern Division, be reversed by this Honorable Court, and your petitioners have such other and further relief in the premises as to this Honorable Court may seem meet and just

WEBSTER AND WEBSTER
PERCY S. WEBSTER
NAYLOR AND LASSAGNE
THEODORE H. LASSAGNE
*Attorneys for Petitioner.*